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DAVIDSON, DAVIDSON & KAPPEL, LLC
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EXAMINER

NGUYEN BA, PAUL H

ART UNIT PAPER NUMBER

2176

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,431

Applicant(s)

BAKER ET AL.

Examiner

Paul Nguyen-Ba

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27, 41-59, 71 and 72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27, 41-59, 71 and 72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This action is responsive to Applicant's Amendment and Remarks filed on 12/14/2005.
2. Claims 1-27, 41-59, 71 and 72 are currently pending. Claims 1, 18, 41, 49, 57, 71, and 72 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-27, 41-59, 71 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson, III et al. ("Dickinson"), U.S. Patent Application Publication No. 2003/0196098, in further view of Motoyama et al. ("Motoyama"), U.S. Patent Application Publication No. 2004/0168079.

Regarding independent claim 1, Dickinson discloses:

A digital communication system to denote confidentiality of a digital communication comprising (see Abstract and Summary):

a processor and a memory containing a program executable by the processor to (see para [0018] → system takes the form of a program executing on a conventional general purpose computer):

attach a privileged attribute to a digital communication (see paras [0023], [0025], and [0030-0031] → policy modules operate on confidential attachments to e-mails (i.e., digital communications) to require either encryption, signature, or

Art Unit: 2176

both, in order to enforce attorney-client privileges) (see also Motoyama as discussed further immediately below);

create a privileged distribution list of at least one intended recipient (see paras [0022-0023] → i.e. recipient policy list);

restrict access to the privileged digital communication to the at least one intended recipient (see paras [0009], [0024] and [0030-0031]);

restrict routing of the privileged digital communication to the at least one intended recipient (see paras [0009], [0024] and [0030-0031]) and,

store the privileged digital communication in a segregated location (...)
on a data storage device (see paras [0010] and [0040-0041] → messages may be stored at specific segregated destinations or queues).

Dickinson does not explicitly disclose:

(...segregated location) for privileged digital communications...

However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to designate a segregated location (i.e., a folder) to hold privileged digital communications for the motivational purpose of facilitating a more efficient method of organizing e-mails. All the major e-mail services had folder options to facilitate the organization of e-mails since their inceptions (e.g. Microsoft Outlook, Hotmail, Yahoo! Mail, etc.).

Regarding independent claim 18, Dickinson discloses:

A digital communication system for denoting confidentiality of a digital communication comprising:

a processor; and, a memory containing a program executable by the processor to (see para [0018] → system takes the form of a program executing on a conventional general purpose computer):

... :

create a privileged distribution list of intended recipients of the digital communication (see paras [0009], [0024] and [0030-0031]);

Art Unit: 2176

restrict access to the digital communication to intended recipients (see paras [0009], [0024] and [0030-0031]);
restrict routing of the digital communication to the intended recipients (see paras [0009], [0024] and [0030-0031]).

Dickinson incorporates, but does not explicitly disclose:

attach an executable module to a digital communication...

However, Motoyama discloses:

attach an executable module to a digital communication... (see para [0103] → the attachment of files including executable files to e-mail messages is a known feature of e-mail messages)

Since Dickinson and Motoyama are both from the same field of endeavor, the motivational purpose of attaching executable files in order to allow for faster and more efficient execution of programming code as disclosed by Motoyama would have been recognized in the pertinent art of Dickinson. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Dickinson with the teachings of Motoyama to include an executable module.

Regarding claim 2, Dickinson discloses:

wherein the at least one intended recipient is a plurality of intended recipients (see para [0031] → policies can be applied to users, either individually or by groupings).

Regarding claim 3, Dickinson discloses:

a mail server (see para [0034]);

Art Unit: 2176

a segregated server housing the segregated location (...) (see paras [0034-0038]);

wherein the program is further executable to send a copy of the communication to the segregated server (see paras [0010], [0034-0038], and [0040-0041]).

Dickinson does not explicitly disclose:

(...segregated location) for privileged digital communications...

However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to designate a segregated location (i.e., a folder) to hold privileged digital communications for the motivational purpose of facilitating a more efficient method of organizing e-mails. All the major e-mail services had folder options to facilitate the organization of e-mails since their inceptions (e.g. Microsoft Outlook, Hotmail, Yahoo! Mail, etc.).

Regarding claims 4, 5, 7, 8, 19, 20, 41, 42, 46, 47, 51, and 52, Dickinson discloses a communication system (i.e. e-mail) containing a plurality of user specified information fields, such as source field specifying an e-mail address for the source of the message, a destination field specifying one or more destination e-mail addresses for the message, a subject field specifying a subject for the message, a body field specifying the body of the message containing textual and/or graphics data, and an optional attachment field, specifying one or more files to be transmitted with the message. Other user specified fields include, but are not limited to, priority

Art Unit: 2176

of the message, identity of the sending agent, and the date and time of the message (see para [0019]).

Dickinson does not explicitly disclose sending a copy as a blind carbon copy, a characteristic including a department of a corporation using the system, forwarding of the communication, and copying and cutting contents into another location.

However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include sending a copy as a blind carbon copy, a characteristic including a department of a corporation using the system, forwarding of the communication, and copying and cutting contents into another location (e.g. Microsoft Outlook, Hotmail, Yahoo! Mail, etc.) for the motivational purpose of comprising the major common functional components of a user-friendly e-mail system.

Regarding claims 6 and 50, Dickinson discloses:

configuring access rights to the digital communication when the document is opened and to enforce said access rights by managing access to the digital communication and controlling the manipulation of its contents (see paras [0009], [0024] and [0030-0031]).

Regarding claims 9, 21, and 54, Dickinson discloses:

executing automatically and attaching the privileged attribute or the executable module to particular communications according to predetermined selection criteria (see para [0022-0031]; please refer also to the rationale relied upon to reject independent claim 18).

Regarding claims 10, 22, and 55, Dickinson discloses

a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication (see para [0039] → i.e. notification actions).

Regarding claim 11, Dickinson does not explicitly teach acknowledging a confidentiality notice by clicking on a GUI button. However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include clicking on a GUI button for the motivational purpose acknowledging a pop-up window (*compare with* “confidentiality notice”).

Regarding claims 12, 23, 56, and 59, Dickinson discloses the system:

wherein the privileged digital communication is encrypted and decryption methods if a predetermined condition is met (see Abstract and para [0007] *et seq.*).

Regarding claims 13 and 24, Dickinson discloses a *server object and a client object* (see paras [0034-0037]).

Claims 14, 15, 17, 25, 26, and 53 incorporate substantially similar subject matter as independent claim 1 and are rejected along the same rationale.

Regarding claims 16 and 27, Dickinson does not explicitly teach that the client object is a plug-in to a pre-existing communication system. However, Dickinson discloses the S/MIME protocol to exchange secure e-mail messages (see para [0034]). It is well known to a skilled artisan that most plug-in modules (e.g. Navigator) are based on MIME file types that simply plugs in to the existing system.

Therefore, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include a plug-in to a pre-existing communication system for the motivational purpose of adding a specific feature or service to a larger system.

Regarding claim 43, Dickinson discloses *executing automatically and attaching the privileged attribute to particular communications according to predetermined selection criteria* (see para [0022-0031]).

Regarding claims 44, Dickinson discloses a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication (see para [0039] → i.e., notification actions).

Regarding claims 45, Dickinson discloses the system *wherein the privileged digital communication is encrypted and decryption methods if a predetermined condition is met* (see Abstract and para [0007] *et seq.*).

Claim 48 incorporates substantially similar subject matter as independent claim 1 and is rejected along the same rationale.

With respect to independent claims 49, 71 and 72, please refer to the rationale relied upon to reject independent claim 18, which contains substantially similar subject matter, as discussed above.

Claims 57 and 58 incorporate substantially similar subject matter as independent claim 18 and are rejected along the same rationale.

Response to Arguments

5. Applicant's arguments with respect to the amended claims filed on 12/14/2005 have been considered but are moot in view of the new ground(s) of rejection, which incorporates the Motoyama et al. reference.

6. Applicant's arguments with respect to the non-amended limitations have been fully considered but they are not persuasive. Specifically, Applicant contends that Dickinson does not teach "attach a privileged attribute to a digital communication". Examiner respectfully disagrees.

Examiner directs Applicant's attention to paras [0023], [0025], and [0030-0031]. Dickinson discloses that policy modules operate on the confidential attachments to e-mails (i.e., digital communications) to require either encryption, signature, or both, in order to enforce

Art Unit: 2176

attorney-client privileges. As further evidenced by Motoyama, the attachment of files including executable files to e-mail messages is a known feature of e-mail messages. Thus, as taught by Dickinson, a confidential/privileged attachment executable module may be attached to a digital communication.

With respect to Applicant's other arguments, Examiner has delineated and expanded upon the rejections above to further clarify the rejection grounds of the cited prior art, including the privileged attribute vs. executable module distinction that Applicant argued in the remarks filed on 12/14/2005.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-4094. The examiner can normally be reached on 11 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PNB


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